

Remarks

Claims 1-18 were pending in the application. Claim 1 has been amended to include the limitations of dependent claim 8. Claims 8, 9 and 16-18 have been cancelled. Therefore, claims 1-7 and 10-15 are currently pending in the application. The specification has been amended for clarity. No new matter has been added by the amendments. Reconsideration is respectfully requested.

Objection to the Specification

The specification is objected to for failing to as failing to provide proper antecedent basis for the claimed subject matter. Specifically, the Examiner stated that "[t]here is lack of proper antecedent basis for the claimed subject matter 'said gift holding box is rectangular', as recited in claim 6, 'said gift holding box is six-sided', as recited in claim 7. Office action, at 2. In response, Applicant submits that the specification has been amended to recite the limitations of the claims. The amendment of the specification is consistent with the patent drawings. No new matter has been added. Specifically, the paragraph beginning at page 2, line 28 and ending at page 3, line 6, has been replaced with another paragraph reciting the limitations of claims 6 and 7. Therefore, the objection should be withdrawn.

Rejections Under 35 U.S.C. § 112

Claim 9 was rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. Specifically, the Office action states, "[t]he subject matter 'said mailing box is uncovered for mailing' is not supported by the original specification and therefore, now constitute New Matter." Office action at 2. Applicant has cancelled claim 9. Therefore, the rejection is moot.

Claims 9 and 16-18 were finally rejected under 35 U.S.C. § 112, second paragraph, for failing to point out and distinctly claim the subject matter which applicant regards as the invention. Applicant submits that claims 9 and 16-18 have been cancelled. Therefore, the rejections are moot. Accordingly, the rejections to claims 9 and 16-18 should be withdrawn.

Rejections Under 35 U.S.C. § 102

Claims 1, 2, 4, 6, 9, and 16-18 were finally rejected under 35 U.S.C. § 102 as being anticipated by McIlhenney. This rejection is respectfully traversed.

Claims 9 and 16-18 have been cancelled. Therefore, the rejection to these claims is moot.

With regard to independent claim 1, it has been amended to incorporate the limitations of dependent claim 8. Claim 8, was rejected under 35 U.S.C. § 103(a) as being unpatentable over McIlhenney. For at least the reason that claim 1 incorporates the limitations of claim 8 which was rejected as being obvious, not anticipated, the anticipation rejection to claim 1 should be withdrawn.

With regard to claim 8, the Examiner stated, "[a]t the time the invention was made, it would have been considered a matter of design choice to a person of ordinary skill in the art... to have the gift holding box of McIlhenney entirely transparent and the top and bottom section transparent because Applicant has not disclosed that the features provides an advantage, is used for a particular purpose, or solves a stated problem." Office action, at 4. Applicant strongly disagrees.

In response, Applicant respectfully submits that Applicant has disclosed that the claimed feature of a top and bottom transparent section, as recited in independent claim 1 incorporating the limitations of independent claim 8, provides an advantage, is used for a particular purpose, or solves a

stated problem. In particular, the specification states, "[w]hen traveling, people often desire to buy gifts for friends and relatives back home. However, given airport bag restrictions, it is cumbersome to transport numerous gifts. Furthermore, if the gift includes metallic elements, a wrapped gift may have to be opened and inspected causing travel delays." Applicant's specification, page 1, lines 17-22. Thus, Applicant has stated a problem in the specification regarding travel delays in Applicant's specification. Accordingly, it is an advantage of Applicant's claimed invention to have a transparent top and bottom section, as seen in Exhibit 1, so that the gift need not be opened for inspection. Therefore, travel delays would be avoided with the present invention.

Additionally, Applicant indicated to the undersigned attorney that he invented the claimed invention with the September 11th attacks in mind knowing that wrapped or metallic items would be viewed as suspicious, especially considering the strict airport security in place as a result of the attacks.

In contrast, the contents of McIlhenney are within a tray that is wrapped. Though the wrap may be transparent, the bottom section of the tray is not taught or suggested to be transparent. Therefore, with the tray of McIlhenney, the entire contents may need to be unwrapped to ensure that nothing is being hidden under the visible contents against the bottom surface of the tray which is not transparent.

Further, another advantage of having a transparent top section and a transparent bottom section is to serve a decorative purpose. Applicant's specification discloses that the inner box of the invention, or the gift holding box as recited in claim 1, "may be entirely transparent, such as a vinyl box. This inner box may include a metallic display item and/or a card." Applicant's specification, page 2, lines 1-3. Applicant submits that a transparent bottom section allows a

card to be visible from the back of the gift holding box providing a decorative backing for any item placed within the gift holding box. As seen in Exhibits 1-6, the card placed within the gift holding box acts as a decorative backing for the particular item being displayed. If the gift holding box were turned around, as seen in the actual product provided (Exhibit 1), the decorative card would be visible from the back. Because the tray of McIlhenney is not taught or suggested to have a transparent back surface, such an advantage would not result.

Thus, the Applicant has clearly stated a problem solved by the invention and has disclosed advantages of having a transparent top section and a transparent bottom section. Accordingly, independent claim 1 should be allowed.

Another advantage of Applicant's claimed invention is that an item within the gift holding box may be viewed when the removable opaque panel is removed from the box. When shipping the device, it is easily determined which items are within the gift holding box, unlike the device of McIlhenney which uses a panel to specify the nature of the contents of the box.

Further, the opaque panel of the present invention is removable and may be put to use for mailing when desired. For example, the removable panel fits over the transparent surface of the gift holding box for quick and easy mailing. Alternatively, it may be removed and stored within a rear portion of the box on top of the transparent bottom section.

Also, the device of the present invention is not and need not be wrapped for mailing. As recited in claim 1, the device includes a mailing box which is in form for mailing. In contrast, McIlhenney teaches allowing easy access to the slide. Such access to the slide is undesirable for mailing as anyone could easily pull the slide out with the pull and change the information or panel. In contrast, in the present invention more effort is required to open the mailing box.

Further, as stated in the previous Office action McIlhenney fails to teach or suggest a gift holding box having a transparent surface. Instead, McIlhenney discloses packing contents of the box in a *tubular member 12* sealed in a transparent paper. The tray of McIlhenney is not disclosed as having a transparent surface. McIlhenney, col. 2, lines 75-79. Specifically, McIlhenney states, "[t]his sealed tray is positioned in the box so that the contents of the tray can be readily inspected through the transparent wrapper..." McIlhenney, col. 2, lines 79-82.

In contrast, Applicant's independent claim 1 recites, "a gift holding box having a transparent surface..." The tray of McIlhenney is not a box for at least the reason that it is described as a tubular member. Further, McIlhenney fails to teach or suggest that a surface of its tray, which the Examiner appears to be equating to the gift box, is transparent. In fact, no mention is made as to the transparency of any surface of the tray of McIlhenney. McIlhenney merely discloses that a transparent wrapping is used without disclosing that the tray itself, which is sealed, includes a transparent surface.

Therefore, for at least these reasons, Applicant respectfully submits that McIlhenney fails to teach or suggest independent claim 1. Accordingly, claims 2-7 and 10-15, which depend either directly or indirectly from claim 1, should be allowed for at least the same reasons as claim 1.

Further, as stated in the previous response to the Office action, with regard to claim 2, the Examiner stated that McIlhenney teaches a display panel inside of the gift box. Applicant respectfully disagrees. In making the rejection, the Examiner cites to col. 2, par. 4 of McIlhenney. This citation describes the sealed tray that the Examiner appears to have previously equated to the gift box. Here, it appears that the Examiner is also equating the "display panel" recited in Applicant's claim 1 to the sealed tray of

McIlhenney. Therefore, it appears the Examiner is referring to the sealed tray as both the gift box and display panel.

In contrast, Applicant's claim 2 recites, "[t]he device of claim 1 further including a display panel inside of the gift box..." Applicant urges the Examiner to examine the device of the present invention (Exhibit 1) and to note that the display panel which supports the metallic item is separate from the gift holding box. A display panel is advantageous for at least the reason that a merchant would have the option of attractively positioning the items for display on the display panel, as also seen in Exhibits 2-6. In Exhibit 2, page J-601, a bracelet is seen supported by the display panel. In Exhibit 3, page B-701 a book is seen supported by the display panel. In Exhibit 4, page 63, a pen is seen supported by the display panel. In Exhibits 1, 5, and 6, decorative metallic items are seen supported by the display panels. As McIlhenney fails to teach or suggest a display panel, in addition, to the sealed tray, Applicant respectfully submits that claim 2 is not anticipated or made obvious by McIlhenney.

Therefore, Applicant submits that claim 2 is novel and non obvious over McIlhenney. Thus, the rejection to claim 2 should be withdrawn.

Rejections Under 35 U.S.C. § 103

Claims 3, 5, 7, and 8 were finally rejected under 35 U.S.C. § 103(a) as being unpatentable over McIlhenny. This rejection is respectfully traversed.

With regard to claims 3, 5, and 7, the Examiner stated that "[a]t the time the invention was made, it would have been considered a matter of design choice to a person of ordinary skill in the art to apply indicia to the mailing box of MicIlhenney, to mount a metal sculpture on the display of McIhhenney...." Office action, at 4.

With regard to claim 3, it depends indirectly on claim 1. Therefore, it is allowable for at least the same reasons as claim 1.

Further, with regard to claim 3, in the previous Office action response Applicant disagreed with the Examiner that it would have been obvious to one of skill in the art to incorporate a metal sculpture on the display panel of McIlhenney. Applicant submitted that McIlhenney failed to teach or suggest a display panel (as discussed above). Therefore, McIlhenney could not teach or suggest a metal sculpture on a display panel for at least these reasons.

Further, McIlhenney was concerned with "display packages for dispensing perishable articles..." McIlhenney, col. 1, lines 1-2. Therefore, there is no teaching or suggestion in McIlhenney to substitute the perishable articles for a metal (non perishable) structure, or to include a metal structure in addition to the perishable articles. For, at least this reason, Applicant submits that claim 3 is in condition for allowance.

In the previous response, Applicant traversed an assertion that the teachings of claim 3 were matters of common knowledge in the art under MPEP § 2144.03, and the Examiner failed to cite a reference in support of her position. Therefore, Applicant submits that claim 3 is in condition for allowance for at least the additional reason that the Examiner failed to cite a reference in support of her assertion.

With regard to claim 5 and as seen in Exhibit 1, the mailing box of the present invention includes printing, unlike the box of McIlhenney. Clearly, the Applicant's specification indicates the advantage of having printing on the mailing box. Specifically, the specification states, "the sender identification lines 22, recipient identification lines 20 and a graphic indication 24 of where to affix the stamp are on the back of the box." Applicant's specification, page 4, lines 11-15. Thus, the advantage is that the mailing box itself

assists a user in mailing by providing identification lines and indicia as to where to affix the stamp. Further, claim 5 depends upon claim 1 and is allowable for this additional reason.

Additionally, in the previous response, Applicant traversed the Examiner's assertion that the teachings of claim 5 were matters of common knowledge in the art under MPEP § 2144.03, and the Examiner failed to cite a reference in support of her position. Therefore, Applicant submits that claim 5 is in condition for allowance for at least the reason that the Examiner failed to cite a reference in support of her assertion.

With regard to claim 7, where the claimed gift holding box is recited as being entirely transparent, the advantages of having a transparent top and bottom section as recited in independent claim 1 apply to claim 7 as well.

Also, unlike the tubular member of McIlhenney, the entire gift holding box, as recited in Applicant's claim 7, is transparent and six-sided. The tubular member of McIlhenney is not entirely transparent nor is it six-sided. An entirely transparent gift box is advantageous for at least the reason that the displayed item is visible from all sides. In McIlhenney, the chocolates may not be viewed from all sides as the tray is not disclosed as being transparent. In contrast to McIlhenney, as seen in Exhibit 1, the card, envelope, and metallic item within the gift holding box are visible from surfaces other than just the top surface.

Further, claim 7 depends upon claim 1 and is allowable for this additional reason.

Claim 8 was cancelled, therefore the rejection to claim 8 is moot. Therefore, for at least these reasons, Applicant submits that claims 3, 5, and 7 are in condition for allowance.

Claims 10-13 were finally rejected under 35 U.S.C. § 103(a) as being unpatentable over McIlhenney in view of

Buchler. This rejection is respectfully traversed. In making the rejection, the Examiner stated, "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to apply sender and mailer identification line printing as taught by Buchler to the panel of McInhenney for the purpose of mailing the gift to a person. Further, it would have been obvious to one having ordinary skill in the art to apply a stamp as suggested by Buchler to the panel of McIlhenney for the purpose of mailing a gift to a person." Office action, at 5.

In response, Applicant respectfully submits that there would be no motivation to combine the McIlhenney and Buchler cited references as McIlhenney was concerned with providing an apparatus for shipping, not mailing. McIlhenney states, "[f]or shipping, the entire package preferably described, will be banded with a wrapper of transparent material 14, through which can be observed the identifying indicia on slide 7, as indicated, *but which will permit access to the slide.*" McIlhenney, col 2., line 34-39 (emphasis). By permitting access to the slide, it is clear that McIlhenney teaches away from using the slide for sender/mailer identification lines and for applying a stamp, as an easily accessible panel is not desirable for mailing an article as anyone could easily change the information on the panel or even remove the panel. Therefore, neither of the cited references provide motivation to combine the two references. Specifically, claim 10 recites, "said printing of said removable opaque panel includes sender identification lines." Claim 11 recites, "said printing of said removable opaque panel includes mailer identification lines." Claim 12 recites, "a metering stamp is disposed on said removable opaque panel." Claim 13 recites, "a stamp is disposed on said removable opaque panel." As these elements are not taught or suggested by the cited references, claims 10-13 are allowable.

Conclusion

For at least the reasons submitted above, Applicant respectfully submits that claims 1-7 and 10-15 are in condition for allowance. Accordingly, a Notice of Allowance is respectfully requested.

Respectfully submitted,

A handwritten signature in cursive script that reads "Gina McCarthy".

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